

15 AUG 2000



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

William R. Evans
LADAS & PARRY
26 West 61st Street
New York, NY 10023

In re Application of :
MONSALVATJE LLAGOSTERA, Montserrat, et al. :
U.S. Application No.: 09/424,673 :
PCT No.: PCT/ES98/00145 :
International Filing Date: 25 May 1998 :
Priority Date: 29 May 1997 :
Attorney's Docket No.: U 012500-4 :
For: PROCESS FOR OBTAINING QUINAPRIL :
HYDROCHLORIDE AND SOLVATES USEFUL :
FOR ISOLATING AND PURIFYING :
QUINAPRIL HYDROCHLORIDE :

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to the petition under 37 CFR 1.47(a) filed on 27 April 2000. Applicants have paid the required petition fee.

BACKGROUND

On 25 May 1998, applicants filed international application PCT/ES98/00145 which claimed a priority date of 29 May 1997 and which designated the United States. On 03 December 1998, a copy of the international application was transmitted to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 03 December 1998, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the IB) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e., 29 November 1999.

On 29 November 1999, applicants filed a transmittal letter for entry into the national stage in the United States which indicates that it was accompanied by, among other materials, a check in the amount of \$840 as the basic national fee, and a translation into English of the international application.

On 07 February 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required. The Notification also informed applicants that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 27 April 2000, applicants filed a "Completion Of Filing Requirements," which was accompanied by, among other materials: (1) a declaration executed by three of the four named inventors (co-inventor Salvador PUIG TORRES did not sign the declaration); (2) payment of the \$130 surcharge for filing the declaration after the applicable deadline; (3) a request for a two-month extension of time to respond to the Notification Of Missing Requirements, with the \$380 payment required for such an extension; (4) the "Petition Under 37 CFR 1.47" considered herein, which seeks acceptance of the declaration without the signature of the nonsigning inventor; and (5) payment of the \$130 petition fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, the submission included a payment of \$130 as the petition fee. Item (1) is therefore satisfied. With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, the declaration submitted contains an unsigned signature block for the nonsigning inventor and it is executed by the other three inventors. Thus, item (3) is satisfied.

However, applicants have not satisfied items (2) and (4). Regarding item (2), applicants have not clearly identified the last-known address of the nonsigning inventor. The declaration includes a post-office address for the nonsigning inventor; however, applicants have not included the required express statement that this address is the last-known address of the nonsigning inventor. Accordingly, item (2) is not satisfied.

As for item (4), the factual proof required to demonstrate a refusal to execute the application documents is set forth in section 409.03(d) of the MPEP, which states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Here, applicants have provided no factual proof of the nonsigning inventor's refusal to sign. The petition simply states that the inventor "refused to sign the application." Applicants must submit evidence of the refusal to sign in the form discussed in the MPEP section quoted above. Applicants should be sure to note that the MPEP states that, before a refusal may be alleged, applicants must provide proper evidence that the complete application (the "specification, including claims, drawings, and oath or declaration") were sent to the nonsigning inventor at his last known address.

Because applicants have failed to satisfy items (2) and (4) of the requirements for a grantable petition under 37 CFR 1.47(a), the petition cannot be granted in its present form.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Failure to file a timely and proper response will result in abandonment.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office

Telephone: (703) 308-6155
Facsimile: (703) 308-6459